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EXAMINER

AGUSTIN, PETER VINCENT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN WILLEM AARTS,
PETRUS CAROLUS MARIA FRISSEN,
and FREDERICUS GERARDUS ANTONIUS HOMBURG

Appeal 2008-2448
Application 09/904,077
Technology Center 2600

Decided: September 24, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,
and MAHSHID D. SAADAT, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-20, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' claimed invention relates to an optical scanning device for scanning an information layer of an optically scannable information carrier (Spec. 1). Claim 1 is illustrative of the invention and read as follows:

1. An optical scanning device for scanning an information layer of an optically scannable information carrier, which scanning device is provided with a radiation source, an optical lens system with an optical axis for focusing a radiation beam supplied, in operation, by the radiation source into a scanning spot on the information layer, and an actuator by means of which the lens system can be displaced with respect to a stationary part of the scanning device at least in a direction parallel to the optical axis, the actuator being provided with an electric coil system, which is arranged in a fixed position with respect to the lens system, and a magnetic system which is arranged in a fixed position with respect to the stationary part, characterized in that the magnetic system, viewed parallel to an X-direction extending perpendicularly to the optical axis, is arranged in its entirety next to and outside the coil system, the magnetic system comprises a first part and a second part on opposite sides of the optical axis, the first part and the second part of the magnetic system each comprise at least a first and a second permanent magnet, at least a part of the coil system being situated in a magnetic stray field of the magnetic system; and the coil system further comprises a portion of the coil system situated symmetrically with respect to a junction of the first and the second magnet for both the first and second part of the magnetic system, said portion being situated between a pair of portions of the coil system arranged directly opposite, respectively, the first and second parts of the magnetic system such that the first and second part of the magnetic system extend entirely across the pair of portions of the coil system.

The Examiner relies on the following prior art reference:

Schell	US 6,058,081	May 2, 2000
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Claims 1-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schell.

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellant did not make in the Briefs have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Under 35 U.S.C § 102(b), does Schell have a disclosure which anticipates the invention set forth in claims 1-20?

PRINCIPLES OF LAW

1. Scope of claims

Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003). The claim construction analysis begins with the words of the claim. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). “[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). Furthermore, the specification is the single best guide to the meaning of a claim term. *Phillips v. AWH Corp.*, 415 F.3d at 1315 (Fed. Cir. 2005).

2. *Anticipation*

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). *Also See In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). “Anticipation of a claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

ANALYSIS

Claims 1, 9, and 16

Appellants dispute the Examiner’s reading of the features recited in claim 1 on elements of the optical scanner of Schell depicted in Figure 26. In particular, Appellants argue that magnetic portions 2-22 and 2-24, characterized as the claimed “first and second part of the magnetic system,” do not extend entirely across coil portions 2-18 and 2-24, which are characterized as the claimed “pair of portions of the coil system” (App. Br. 8-9). Appellants argue that the dictionary meaning of the term “entirely” is wholly or completely, which is different from the partial coverage of the coils by the magnetic portions (App. Br. 9). Additionally, Appellants assert that nothing in the instant disclosure could reasonably lead to the interpretation of the claim as being equivalent to the parts of the magnetic system extending partially across the pair of portions of the coil system (*id.*).

The Examiner provides two annotated versions of figure 26 of Schell to show how the Examiner characterizes the positioning of magnets 2-22 and 2-24 as extending entirely across the coils 2-18 and 2-20 in the Z direction (Ans. 13). Furthermore, the Examiner provides a second interpretation where the “portion” is interpreted as a segment of elements 2-18 and 2-20 that lies within the length of elements 2-22 and 2-24 (Ans. 14).

Initially, we observe that Appellants have not pointed to any portion of the Specification for defining the term “the first and second part of the magnetic system extend entirely across the pair of portions of the coil system.” Instead, Appellants rely on the configuration depicted in Figure 3A to define the claim language (App. Br. 9). While Appellants’ Figure 3A shows the magnetic parts 61/67 and 61/69 with a larger surface area compared with that of the coil system portions 87 and 89, the claims are not delimited so as to precisely require the magnetic parts to extend across and cover the entire pair of portions of the coil system.

We find the Examiner’s interpretation of “extend entirely across,” as depicted on pages 13 and 14 of the Answer to be reasonable and consistent with Appellants’ disclosure. In particular, based on the first interpretation on page 13, the Examiner points out that magnet 2-24 extends, by its entire height, across the coil portion 2-20 in the Z-direction. As long as Schell shows that the magnet extends entirely in at least one direction, the claim reads on the embodiment depicted in Figure 26 of Schell. Similarly, as shown in the Examiner’s second interpretation shown on page 14 of the Answer, the Examiner shows that the magnet part 2-24 extends entirely across the pair of portions of coil 2-20 since the identified area corresponds to a portion of the coil across which the magnetic part 2-24 extends entirely.

Giving the claim its broadest reasonable interpretation without importing limitations from the Specification, we find the Examiners interpretations to be reasonable since the claim does not delimit “extend entirely across” to covering the entire surface of the coil. Therefore, in view of the discussions above, we sustain the 35 U.S.C. § 102(b) rejection of claim 1 and independent claims 9 and 16, which are argued based on the same principles presented for claim 1 (App. Br. 14-15 and 18-19).

Claims 2-8, 10-15, and 17-20

With respect to the remaining claims, we note that Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims. In addition to relying on the same argument presented for claim 1 which we found *supra* to be unpersuasive, Appellants repeat the claim limitations recited in each claim and merely assert that Schell does not disclose or suggest such limitations (App. Br. 10-13, 15-18, and 20-21). We remind Appellants that reproduction of claim language coupled with an allegation of patentability does not constitute an argument for separate patentability of the claim, nor demonstrates error in a rejection. In the absence of a separate argument with respect to the dependent claims, those claims fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we sustain the 35 U.S.C. § 102(b) rejection of claims 2-8, 10-15, and 17-20 over Schell.

ORDER

The decision of the Examiner rejecting claims 1-20 is affirmed.

Appeal 2008-2448
Application 09/904,077

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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